

REMARKS

Claims 32-51 are pending in this application. Claims 45-51 stand withdrawn. By this Amendment, claims 32, 41 and 45 are amended. The claim amendments are made only to clarify the subject matter previously recited in the claims and do not narrow the scope of the claims or affect the patentability thereof. No new matter is added.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration since the amendments amplify issues previously discussed throughout prosecution; (c) satisfy a requirement of form asserted in the previous Office Action; and (d) place the application in better form for appeal, should an appeal be necessary. Entry of the amendments is thus respectfully requested.

I. Power of Attorney/Mailing Address

A Power of Attorney, including a change of address, was filed in the U.S. Patent and Trademark Office on November 2, 2004. The Power of Attorney was duly recorded as evidenced by the copy of the transmittal of Power of Attorney and Statement Under 37 C.F.R. §3.73(b) that is available in the electronic file wrapper of this application having a date stamp of November 2, 2004. Therefore, Applicants again respectfully request that all further communications be forwarded to Oliff & Berridge, PLC, at the address as provided on the Power of Attorney as previously requested in the Amendment filed on April 18, 2005.

II. Election Restriction

Claims 45-51 stand withdrawn in this application and are now alleged to be improperly dependent on claim 32. The Office Action fails to indicate why the amended claims are improper or to provide support for the alleged improper dependency. Although the claims are not improperly dependent, in an effort to expedite prosecution, independent

claim 45 is amended to specifically incorporate the subject matter of claim 32, thereby linking independent claim 32 and claims 45-51.

Additionally, the Office Action relies on claim language that is not recited in the claims to maintain the restriction requirement. Applicants again submit that there is no materially different apparatus that may be used to practice the method of claims 45-51 because claims 45-51 specifically incorporate the subject matter of apparatus claim 32. Applicants point out that reliance upon claim language that is not recited in the claims to maintain a restriction requirement is improper.

Furthermore, in the event the restriction is maintained, Applicants point out that upon allowance of apparatus claim 32, process claims 45-51 must be allowed. MPEP §821.04 recites, "If Applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined" (emphasis added). The MPEP further recites that where the application as originally filed discloses the product and the process or for making and/or using the product, and only claims directed to the product are found presented or for examination, when a product claim is found allowable, Applicants may present claims directed to the process of making and/or using the patentable product by way of an Amendment pursuant to 37 C.F.R. §1.121. In view of the rejoinder process and in order to expedite prosecution, Applicants are encouraged to present such process claims, preferably as dependent claims, in the application at an early stage of prosecution. Process claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the Amendment is presented prior to Final Rejection or for allowance. Thus, as the pending withdrawn process claims were presented prior to the Final Rejection of the product claims, Applicants submit that upon allowance of the product claims, process claims 45-51 must be rejoined and allowed.

III. Claim Rejections Under 35 U.S.C. §112

Claim 41 is rejected under 35 U.S.C. §112, second paragraph. Specifically, it is alleged in the Office Action that the recitation of "further comprising an air conditioner" in claim 41 represents a "double recitation" of the air delivery system already recited in base claim 32.

Applicants presume that the allegation of a "double recitation" is intended to relate to a prohibition against "duplicate claiming". Claim 41 is not a duplicate claim of independent claim 32 as the recitation of the air conditioner recited in claim 41 further narrows the scope of claim 32 by further defining the air delivery system and reciting the feature of "wherein the controller operates the air conditioner during the early morning hours to pre-cool a building."

It is alleged in the Office Action that "an air conditioning apparatus inherently includes an air delivery system" (see page 3, last paragraph). However, as an air delivery system of claim 32 does not inherently include an air conditioner, the scope of the claim is further narrowed at claim 41.

Additionally, as recited in MPEP §706.03(k) regarding duplicate claiming, it is acknowledged that court decisions have confirmed Applicants' right to restate (i.e., by plural claiming) the invention in a reasonable number of ways. A mere difference in scope between claims has been held to be enough.

Claim 41 is further rejected under 35 U.S.C. §112, second paragraph, or for failing to recite necessary structural connections. As claim 41 is amended in reply to the rejection, withdrawal of the rejection of claim 41 under 35 U.S.C. §112, second paragraph, is respectfully requested.

IV. Claim Rejections Under 35 U.S.C. §102

Claims 32-44 are rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,775,944 to Nakamura. The rejection is respectfully traversed.

Nakamura fails to disclose each and every feature recited in the pending claims, as amended. For example, Nakamura fails to disclose or suggest a system for using outside ventilation air to maintain indoor comfort and air quality, comprising a sensor system or for detecting outdoor and indoor air temperatures; an air delivery system or for delivering the outside ventilation air to an interior space; and a programmable controller, operably connected to the sensor system and the air delivery system, that includes a recovery element that receives an outdoor air temperature and an indoor air temperature detected by the sensor system; a storage element that stores the detected outdoor air temperature and the detected indoor air temperature detected by the sensor system; a calculating element that automatically calculates a predicted indoor temperature range and a predicted outdoor temperature range based on the stored outdoor air temperature and the stored indoor air temperature; and a regulating element that automatically regulates operation of the air delivery system as a function of predicted indoor and outdoor air temperature ranges and a predetermined indoor air temperature range, as recited in amended claim 32.

As pointed out in the April 18, 2005, Amendment Nakamura discloses a system which calculates the optimum operation condition of an air conditioner and/or hot water supplying apparatus using the operating state information of a central heat source, the weather information, the indoor atmosphere information and a consumer's request, and displays the optimum operating condition on the consumer's display unit. Therefore, the consumer can easily operate the air conditioning and/or hot water supplying apparatus by obeying the displayed message, (col. 4, lines 1-13).

The various messages displayed on the consumer's display unit are drawn up and transmitted to an output terminal device 14 in each of a number of dwelling units via their respective controllers 12 (col. 3, lines 1-5). The messages displayed to the consumer include promotional information which teaches a desired or preferable operation, incentive

information which teaches the advantages to the consumer when the consumer cooperates in making the heat load even or saving energy, discouragement information which indicates the irrationality of certain kinds of operation of the air conditioner apparatus or warns not to operate in such a fashion, and penalty information which imposes a penalty when certain kinds of operation of the air conditioner are performed (col. 3, lines 44-65). Thus, the controller 12, alleged to correspond to the controller recited in the rejected claims, is only disclosed as relaying various messages as described above to the output terminal device 14 in each of a number of dwelling units via their respective controllers. Thus, the system of Nakamura does not control an air delivery system but rather, merely generates messages to be forwarded to the consumer to provide information regarding operation of the heating and cooling system.

In the Response To Arguments section of the Office Action, it is alleged that "the messages to the user are a way of regulating the operation of the air delivery system". Thus, it appears that the user is alleged to perform the function of the controller recited in the rejected claims. Applicants respectfully point out that the case law precludes a conclusion that a human being is a corresponding structure or an equivalent to a structure. (See, for example, Default Proof Credit Card System, Inc. v. Home Depot U.S.A., Inc., Appeal No. 05-1069, CAFC, June 16, 2005.) Furthermore, a requirement of human intervention precludes anticipation, as discussed in *In re Prater*, 415 F.2d, 1393, 1406.

Additionally, the Office Action again indicates that "little or no patentable weight is given to purely functional language and optional/conditional limitations in the apparatus claims." The Office Action states that claims directed to an apparatus must be distinguished from the prior art in terms rather than function and that apparatus claims cover what a device is, not what a device does.

However, as recited in MPEP §2114, the features of an apparatus may be recited either structurally or functionally and must be distinguished from the prior art in terms of structure rather than function. Thus, describing the structural features or elements of the controller by their function accurately describes the features of the controller which differentiates the structural features or elements from the applied reference. Furthermore, as previously pointed out, there is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. A functional limitation must be evaluated and considered, just like any other limitation of a claim, for what it fairly conveys to a person of ordinary skill in the pertinent art and the context in which it is used (See MPEP §2173.05(g)).

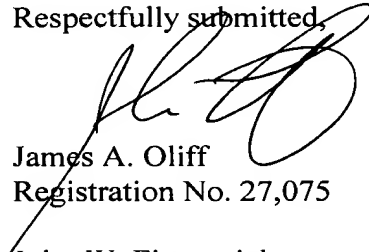
As Nakamura fails to disclose each and every feature recited in the rejected claims, and because reliance on a human as a corresponding structure or equivalent structure, is improper, Nakamura fails to disclose each and every feature recited in the rejected claims. Accordingly, withdrawal of the rejection of claims 32-44 under 35 U.S.C. §102(b) is respectfully requested.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition or for allowance. Favorable reconsideration and prompt allowance of claims 32-51 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition or for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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